

## **REMARKS/ARGUMENTS**

Claims 1, 3-11 and 14-42 are pending in this application. Claims 1, 3, 4, 8, 9, 14, 21-23, 27-30, 35 and 36 have been amended to further clarify what applicants deem as their invention and to further distinguish the invention from the cited references. These amendments are completely supported by the application as filed and thus they raise no issue of new matter. Claim 11 has been canceled without prejudice or disclaimer of applicants' right to pursue patent protection for the subject matter of that claim in a subsequent application. Entry of this Amendment into the file of the application is respectfully requested as it is believed to place the entire application in condition for allowance, or at a minimum to materially reduce the issues for an appeal. Upon entry, claims 1, 3-10 and 14-42, as amended are pending in the application. In light of the amendments and Remarks provided herein, the Examiner is respectfully requested to reconsider and withdraw her objections and rejections so that the application may proceed to issuance.

### **Claim Objections**

Claims 21 and 27 have been amended to correct a typographical error. As amended, these claims both begin with a capital letter.

The cancellation of claim 11 (without prejudice or disclaimer) renders moot the objection to that claim recited in ¶3 of the Office Action.

Claims 14 and 36 have been amended in a manner which is believed to overcome the objections to claims 14, 36 and 37.

The Examiner is respectfully requested to reconsider and withdraw her objections to the claims as set forth in the Office Action.

### **Rejections Under 35 U.S.C. §112**

#### **A) Rejections Under 35 U.S.C. §112, First Paragraph**

Claims 1, 3-11 and 14-42 are rejected under 35 U.S.C. §112, ¶1 for allegedly failing to comply with the so-called "written description" requirement of the statute, for the reasons set forth in paragraph 5 of the Office Action. In response, the claims have been amended in a manner which

is believed to overcome the “written description” rejection. The Examiner is therefore respectfully requested to reconsider and withdraw the subject rejection based upon the amendments and remarks provided herein.

Claims 4, 5, 8-10, 28-34, and 40-42 are rejected under 35 U.S.C. §112, ¶1 for allegedly failing to comply with the so-called “enablement” requirement of the statute for the reasons set forth in paragraph 6 of the Office Action. In response, the claims have been amended in a manner which is believed to overcome the enablement rejection. The Examiner is therefore respectfully requested to reconsider and withdraw the subject rejection based upon the amendments and remarks provided herein.

#### **B. Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 1, 3-11 and 14-42 are also rejected under 35 U.S.C. §112, ¶2 as being allegedly indefinite for the reasons set forth in paragraph 8 of the Office Action. In response, the claims have been amended in a manner which is believed to overcome the indefiniteness rejection. The Examiner is therefore respectfully requested to reconsider and withdraw the subject rejection based upon the amendments and remarks provided herein.

#### **Rejections Under 35 U.S.C. §102**

Claims 1, 11, 14-16, 28, 35 and 40 are rejected under 35 U.S.C. §102(b) over McMills et al. U.S. Patent No. 5,490,803 (“McMills”) and as evidenced by Visser U.S. Patent No. 4,694,122 (“Visser”) and Gordon et al., USGS Primer for Acid Rain - “USGS Tracks Acid Rain (“Gordon”) for the reasons set forth in ¶10 of the Office Action. This rejection is respectfully traversed for the reasons which follow.

McMills teaches, in a first embodiment, a method of connecting the termini of two or more coaxial, i.e, electrical, cables. The coaxial cables have a central axial conductor and at least one outer concentric conductor. The method comprises the steps of: coating the concentric conductors with an oxide abrading sealant, connecting the central axial connectors, and connecting the concentric conductors. The oxide abrading sealant is sufficiently abrasive to abrade away metal oxides from the concentric conductor termini during the connection step, but is not so abrasive so

as to damage the thin foil and/or wire braid at the cable terminus. In another embodiment, the invention is directed to a coupling device for oxidatively sealing a coaxial cable, i.e., an electrical cable, to a cable port or a cable splice. The coupling device comprises a cable connector having at least one connection end which contains a sealing amount of an oxide abrading sealant.

It is applicants' view that the invention claimed in the Amendment filed August 12, 2004 is completely distinguishable over the cited reference in view of the fact that the prior art reference relied upon to reject applicants' claims is directed to an electrical cable, in particular a coaxial cable, not to an ion-exchange system as presently claimed. Nevertheless, to even further distinguish their invention from the cited art, claim 1 (the only independent claim) is amended herein to further specify that the layer of ion-conducting material forms an ion-selective membrane. This amendment is supported by the teaching found at p. 21, lines 12-14 and thus no new matter has been introduced.

With reference to the coaxial cable described in McMills, notwithstanding that there may occur a rare condition wherein the outer insulating sheet of the cable taught by the reference became immersed in some kind of salt solution and, as a consequence, a layer is formed which conducts electrical currents on the surface of the cable, the reference contains nothing which would teach or even suggest to one of ordinary skill in this art to form an ion-selective membrane, such as is now specifically recited in amended claim 1. Since for a reference to anticipate a claimed invention, the reference must disclose each and every element of that invention, claim 1 is not anticipated by McMills since there is no disclosure in McMills of the ion-selective membrane. The remaining claims of the application depend, directly or indirectly, on claim 1 and thus are distinguishable for the same reasons as claim 1.

Moreover, neither Visser nor Gordon contain any teaching which would suggest to one of ordinary skill to provide such an ion-selective membrane in the coaxial cable disclosed in McMills. Thus the claimed invention is also not obvious over McMills taken with one or both of Visser and/or Gordon. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of claims 1, 11, 14-16, 28, 35 and 40 over the '803 patent to McMills, whether taken by itself or in conjunction with Visser and/or Gordon.

Claims 1, 11, 14-16, 28, 35 and 40 are also rejected under 35 U.S.C. §102(b) over Brake et al. U.S. Patent No. 6,288,328 ("Brake") and as evidenced by Gordon for the reasons set forth in ¶11 of the Office Action. This rejection is respectfully traversed for the reasons which follow.

As in the case of the McMills reference, Brake also is directed to an coaxial electrical cable, which is totally unlike the presently claimed ion-exchange system. The reference discloses a coaxial cable which includes an inner metallic conductor separated from an outer metallic conductor by a layer of electrical insulation having a predetermined thickness. The insulated inner conductor is effectively rotated about its longitudinal axis at a predetermined rate of revolution relative to the outer conductor in order to improve the structural return loss performance of the resulting cable.

There is no recognition within the subject reference, however, to incorporate an ion-selective membrane such as that which is now specifically recited in applicants' claim 1. Thus, as the subject reference does not disclose each and every one of the claimed elements which together comprise the present invention, neither claim 1, nor any of the claims depending from that claim, is anticipated by the Brake patent. Additionally, as noted above the Gordon reference fails to supply the element missing from the disclosure in the Brake patent, and thus the invention as now claimed is also not obvious over the combination of Brake and Gordon. The Examiner is thus respectfully requested to reconsider and withdraw the §102 rejection based upon the Brake patent.

### **Summary**

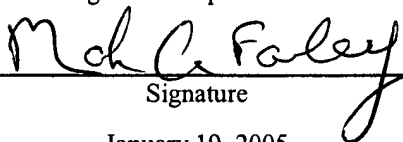
Claims 1, 3-10 and 14-42 are believed to meet all of the requirements under 35 U.S.C. §112 and to distinguish the invention over all of the references cited by the Examiner. The Examiner is therefore respectfully requested to reconsider and withdraw all of her objections and rejections of the claims so that the present application may be allowed, early notice of which would be

appreciated. If the Examiner believes that a telephone interview would advance the prosecution of this application, she is respectfully requested to telephone applicants' representative at the number provided below.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 19, 2005:

Mark A. Farley

Name of applicant, assignee or  
Registered Representative

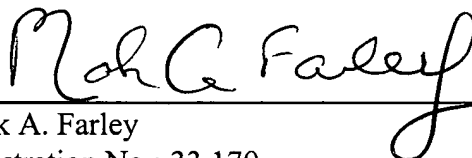


Signature

January 19, 2005

Date of Signature

Respectfully submitted,



Mark A. Farley

Registration No.: 33,170

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700

MAF:db